

REMARKS

APPLICATION STATUS

Claims 26-46 are pending in the Application.

Claims 26-28, 33-34 and 40-42 (containing each of the independent claims) are rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,842,185 ("Chancey").

Claims 29-32, 36-39 and 43-46 are rejected under § 103(a) as being unpatentable over Chancey in view of Quicken 5, evidenced by a book Home Banking with Quicken ("Cummings").

CONTROLLING LAW

The Applicants wish to focus the Examiner's attention on the concept of hindsight applied to the law of obviousness, and to the role of conception in invention:

- 1) "Obviousness can only be established by combining or modifying the teachings in the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either in the references themselves or in the knowledge generally available ... in the art." MPEP § 2143.01, In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- 2) "Good ideas may well appear 'obvious' after they have been disclosed, despite having been previously unrecognized." Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 1479, 43 USPQ2d 1294, 1296 (Fed. Cir. 1997).
- 3) "Close adherence to this methodology (of considering the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field) is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.'" In re Dembiczak, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).
- 4) "The primary meaning of the word 'invention' in the Patent Act unquestionably refers to the inventor's conception ..." Pfaff v. Wells Elects. Inc., 525 U.S. 55, 66 (1998).

In this response, the Applicants' invention and the Chancey reference are discussed. Applicants' invention includes the concept of changing the payee name to a preferred payee name in a financial statement. The Chancey reference does not include the concept of changing the payee name. The Chancey reference instead includes the concept of changing a payee category with a specific algorithm. The concept of changing a payee name to a preferred payee

name and its attendant advantages is a fundamental part of the Applicants' invention (please see the above quote from Pfaff v. Wells).

The Applicants respectfully suggest that it is impermissible hindsight to hold that the Applicants' claims are obvious over Chancey. Unless a prior art reference includes the concept of changing a payee name to a preferred payee name in a financial statement rather than changing another aspect of a financial statement, it is impermissible hindsight to conclude that the Applicants' invention is obvious over the prior art reference.

APPLICANTS' INVENTION

Applicants' invention is directed to automatically replacing in a financial statement a received payee name in a financial transaction with a preferred payee name received from a user in each occurrence of the payee name. Applicants' independent claim 26 includes four elements summarized as follows:

(1) receiving a financial statement that comprises at least one transaction entry including a payee name and a transaction amount and receiving a user command to replace the payee name with a preferred payee name; (2) creating a data structure including a record to associate the payee name with the preferred payee name; (3) automatically replacing the payee name with the preferred payee name for each financial statement payee name occurrence; and (4) receiving a subsequent financial statement comprising at least one transaction entry including a payee name and a transaction amount as in and automatically checking the data structure for the record associating the payee name with the preferred payee name, and replacing the payee name with the preferred payee name for each financial statement payee name occurrence as in (3) above.

Applicants' independent claim 33 recites a computer system to perform the claim 26 steps. Applicants' independent claim 40 recites a computer-readable medium on which is stored a program which when executed perform the claim 26 steps.

The Office Action addresses the elements of claim 1 as representative of the elements of claims 33 and 40 with regard to § 103 obviousness. The Applicants accept this approach.

THE CHANCEY PATENT

Chancey discloses in both the Description and the claims, a process only for automatically assigning a category to a financial transaction of a computer-maintained record of financial transactions, and does not disclose changing a payee name in the record.

In the Chancey Description, a process is disclosed with reference to Fig. 3 to update a credit card account 24 (Chancey Fig. 1) of a financial management program 20 (Chancey Fig. 1).

The process gets a next transaction 34, and determines if the transaction already exists 36. If the transaction already exists, the process uses the category assigned for the transaction 38 and gets the next transaction; if the transaction does not already exist, the process determines whether any existing transaction has the same payee 40. If an existing transaction has the same payee, the category of the existing transaction is assigned the transaction 42, and then a next transaction is processed, if an existing transaction does not have the same payee 40, the merchant category is matched to a code category if a code category exists 46, 48; and then a next transaction is processed. If a code category does not exist 46, a user chooses a category 50, and a next transaction is processed. (Chancey col. 4, line 22 to col. 5, line 22; Chancey Fig. 3).

CLAIMS 26, 33 AND 40 ARE NOT OBVIOUS OVER CHANCEY

The Office Action states that with regard to the Applicants' claim 26 element (1), ("receiving a user command replacing the received payee name with a preferred payee name"), "Chancey teaches receiving a user command to change information within the financial system." Applicants' element (1) is not the same element as the above general description ("receiving a user command to change information") of Chancey. Applicants respectfully suggest that Chancey does not disclose the concept of automatically replacing (changing) a payee name (according to a recited algorithm). Applicants' element (1) is directed to a completely different concept than Chancey - a payee name. Chancey is directed to payee category. Chancey does not disclose the concept of receiving a user command to replace a received payee name with a preferred payee name. Applicants respectfully suggest that Chancey does not disclose element (1) of Applicants' claim 26.

The Office Action states that with regard to Applicants' claim 26 element (3), ("automatically replacing the received payee name with the preferred payee name for each occurrence of the received payee name in the financial statement"), "Chancey teaches searching previous transactions for equivalent data for the same payee." Applicants traverse that Chancey includes that what the Office Action states. Applicants respectfully suggest that Chancey instead includes searching a previous transaction for the same payee (Chancey Fig. 3 block 40, col. 4 lines 55-56), and for using that category in the current transaction (Chancey Fig. 3 block 48, col. 5 lines 12-13). Even if Chancey were to include (teach) "searching previous transactions for equivalent data for the same payee," such a teaching would not include the concept of automatically replacing the received payee name with the preferred payee name for each

occurrence in the financial statement. Chancey does not disclose this concept. Applicants respectfully suggest that Chancey does not disclose element (3) of Applicants' claim 26.

The Office Action states that it is "obvious ... to search a database or table or entries for a common entry and associate the two, or change to a new name." The Office Action does not indicate the element of Applicants' claim 26 to which this comment is directed. Applicants assume the comment is directed to Applicants' element (2): "creating a data structure including a record associating the received payee name with the corresponding preferred payee name," because each relates to a data unit. Applicants respectfully suggest that Chancey does not include the Applicants' element (2) concept of creating a data structure associating the received payee name with a preferred payee name. Applicants respectfully suggest that Chancey does not include a disclosure of a concept to associate a received payee name with a preferred payee name, and moreover, there is not a suggestion in Chancey to do so. Applicants respectfully suggest that Chancey does not disclose element (2) of Applicants' claim 26.

The Office Action states that Chancey (a) "includes adjusting account balances and correcting payee names (Chancey col. 6, lines 11-19)" and teaches (b) "receiving the user command to change the information" and (c) "then searching the transaction files to change all the occurrences of this change." The Office Action does not indicate the element(s) of Applicants' claim 26 to which this comment is directed.

Applicants' assume that comment (a) and comment (b) are directed to Applicants' claim 26 element (1) that recites receiving "a user command" to replace a payee name with a preferred payee name, because (b) states a "user command" to change information, the phrase "user command" being in common with the Office Action comment. With regard to comment (a), Applicants respectfully traverse that Chancey includes what the Office Action states. Applicants respectfully suggest that Chancey Col. 6, lines 11-19 instead recites: "determining with the processor if a payee of the transaction is the payee of a previous transaction stored in the storage device; if the payee for the transaction is the payee of a previous transaction stored in the storage device, assigning with the processor the transaction to a category associated with the previous transactions."

Even if Chancey were to teach comment (a) and comment (b) above, Applicants respectfully suggest that Chancey nevertheless would not include the concept of replacing a

payee name with a preferred payee name in reference to Applicants' element (3). Applicants respectfully suggest that Chancey does not disclose element (3) of Applicants' claim 26.

Applicants' assume that comment (a) and comment (c) are directed to Applicants' claim 26 element (4) that recites automatically checking the data structure for the record associating the payee name with the preferred payee name and replacing the payee name with the preferred payee name for each payee name occurrence, because comment (c) includes the word "occurrences" and element (4) includes the word "occurrence." With regard to comment (a), Applicants traverse that Chancey includes what the Office Action states according to the analysis presented above with regard to comment (a). With regard to comment (c), Applicants do not read this in Chancey and traverse that the Chancey reference includes what the Office Action states. Applicants respectfully suggest that comment (c) can only refer, according to the Chancey disclosure and referencing Chancey, to changing occurrences of category and (not the concept of changing a payee name) if an existing transaction does not have the same payee (Chancey Fig. 3 block 40), the merchant category is matched to a code category if a code category exists (Chancey Fig. 3 blocks 46, 48) and then a next transaction is processed. If a code category does not exist (Chancey Fig. 3 block 46), a user chooses a category (Chancey Fig. 3 block 50), and a next transaction is processed. Applicants respectfully suggest that Chancey does not disclose element (4) of Applicants' claim 26.

For Applicants' claim 26 to be obvious over Chancey, each of the elements (1) - (4) taken as a whole must be obvious over Chancey. Applicants respectfully suggest that Chancey does not render obvious any of the Applicants' claim 26 elements (1) - (4). Accordingly, Applicants respectfully suggest that Applicants independent claims 26, 33, and 40 are not obvious over Chancey because any of elements (1) - (4) is not obvious over Chancey.

Some of the Office Action comments with regard to Chancey and the subject Application do not include a specific reference to an element of Applicants' claims, and/or do not designate the particular part of the reference relied upon, and/or do not specify the pertinence of each reference as required by the CFR and the MPEP (37 CFR § 1.104, MPEP § 706.02(j), MPEP § 706.07, MPEP § 707). Applicants respectfully request that any future Office Action include a specific reference to an element of Applicants' claims, designate the particular part of the reference relied upon, and specify the pertinence of each reference so that the Applicants can properly respond to that Office Action.

CLAIMS 29, 36 AND 43 ARE NOT OBVIOUS OVER CHANCEY IN VIEW OF QUICKEN 5
EVIDENCED BY HOME BANKING WITH QUICKEN

With reference to Applicants' claims 29, 36, and 43, the Office Action states that a prior Office Action (03/02/00 Paper Number 14) cited Cummings to show obviousness in view of Quicken. Applicants respectfully traverse. The 03/02/00 Office Action indicates on page 8, that Cummings pages 83-89 includes Applicants' claim 29 elements.

The Applicants do not read in either Office Action any analysis of a correspondence of Applicants' claim 29 elements to any specific section of Cummings. The Applicants do not read in the cited pages in Cummings any of Applicants claim 29 elements. Moreover, Applicants see no suggestion in Chancey to combine the teachings of Chancey with the teachings of Cummings. Applicants respectfully request a more specific indication of that portion of the cited art relied on to reject the claims if the rejection is maintained in conformance with the CFR and the MPEP. The Applicants respectfully suggest that claims 29, 36, and 43 are not obvious over Chancey in view of Cummings.

Applicants' claims 29, 36, and 43 depend from claims 26, 33, and 40 respectively and each is therefore believed to be patentable over Chancey in view of Quicken evidenced by Cummings for the same reasons articulated above with respect to claim 26, as well as for the additional recitation they contain.

CLAIMS 27, 28, 30, 31, 32, 34, 35 37, 38, 39, 41, 42, 44, 45, AND 46

Applicants respectfully suggest that the referenced prior art does not suggest Applicants' above claims, either alone or together. Applicants respectfully request a specific indication of that portion of the cited art relied on to reject these claims if the rejection is maintained in conformance with the CFR and the MPEP.

Applicants' respectfully suggest that claims 27, 28, 34, 35, 41, and 42 are not obvious in view of Chancey for the same reason articulated above with respect to claim 26, as well as the additional recitation they contain. Applicants' respectfully suggest that claims 30, 31, 32, 37, 38, 39, 44, 45, and 46 are not obvious in view of Chancey over Cummings for the same reason articulated above with respect to both claim 1 and claim 29, as well as the additional recitation they contain.

CONCLUSION

In conclusion, Applicants respectfully submit that claims 26-46 are now in a condition for allowance, and Applicants respectfully request allowance of such claims.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, he is herein requested to call Applicants' attorney at the phone number noted below.

Respectfully Submitted,
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